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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,542	08/03/2000	Ryoichi Imanaka	MAT-3720US3	9883

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EXAMINER	
PARRY, CHRISTOPHER L	
ART UNIT	PAPER NUMBER
2421	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/631,542	IMANAKA, RYOICHI	
	Examiner	Art Unit	
	CHRIS PARRY	2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date. _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 14-16 is withdrawn in view of the newly discovered reference(s) to Yoo in view of Horton. Rejections based on the newly cited reference(s) follow.

Response to Arguments

2. Applicant's arguments with respect to claims 14-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 14-15 recite a recording medium comprising an identifier and information which do not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material. Such nonfunctional descriptive material, in the absence of a functional interrelationship with a computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se.

Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. Sec. 101. Certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture or composition of matter.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 16 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The claimed method including steps of providing a recording medium having an identifier is broad enough that the claim could be completely performed mentally, manually, verbally or without a machine nor is any transformation apparent.

For example, providing a recording medium or "piece of paper" having an identifier or "user's name, address, etc."; recording said information or "writing

data/information" on said recording medium or "paper" based on a presence of said identifier (i.e., only data/information intended for user identified by the identifier); and allowing recording or "writing" of said information or "data" on said recording medium or "paper" to effect charges or "charge or receive a fee from the user" for said information or "data".

Thus the method of claim 16 could be interpreted broadly enough where the performed method could be executed manually by a user. The instant claim is not positively tied to a particular machine that accomplishes the claimed method steps.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoo (USPN 5,497,240) in view of Horton et al. "Horton" (USPN 4,945,563).

Regarding Claim 14, Yoo discloses a recording medium (i.e., video cassette tape) for recording information (Abstract), said recording medium comprising:

an identifier (i.e., tape ID code) (Col. 4, lines 27-52); and

wherein said information is recorded on said recording medium based on a presence of said identifier (i.e., before recording of a desired program can begin, microcomputer 90 must first detect the presence of tape ID code on the recording

medium in order to facilitate properly indexing the recording medium) (figure 2; Col. 4, lines 27-52 and Col. 5, lines 1-25).

Yoo however fails to specifically disclose wherein recording of said information on said recording medium effects charges for said information.

In an analogous art, Horton discloses wherein recording of said information on said recording medium effects charges for said information (i.e., the subscriber pays a first fee to view a program and pays a second higher fee in order to view and record the program) (Col. 2, lines 59-65 and Col. 3, lines 39-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yoo to include wherein recording of said information on said recording medium effects charges for said information as taught by Horton for the benefit of efficiently charging a subscriber a fee only for programs that are recorded.

Regarding Claim 15, Yoo discloses a recording medium, comprising:

information (i.e., subscriber's desired program to be recorded and corresponding ID code) (Col. 4, lines 38-52); and

an identifier (i.e., tape ID code) (Col. 4, lines 27-52); and

wherein said information is recorded on said recording medium based on a presence of said identifier (i.e., before recording of a desired program can begin, microcomputer 90 must first detect the presence of tape ID code on the recording medium in order to facilitate properly indexing the recording medium) (figure 2; Col. 4, lines 27-52 and Col. 5, lines 1-25).

Yoo however fails to specifically disclose wherein recording of said information on said recording medium effects charges for said information.

In an analogous art, Horton discloses wherein recording of said information on said recording medium effects charges fro said information (i.e., the subscriber pays a first fee to view a program and pays a second higher fee in order to view and record the program) (Col. 2, lines 59-65 and Col. 3, lines 39-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yoo to include wherein recording of said information on said recording medium effects charges fro said information as taught by Horton for the benefit of efficiently charging a subscriber a fee only for programs that are recorded.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horton in view of Yoo.

Regarding Claim 16, Horton discloses a method for charging for information (Col. 3, lines 39-60), said method comprising the steps of:

providing a recording medium (i.e., video cassette tape to be used by special VCR 44) (Col. 4, lines 1-19 and Col. 2, lines 30-52); and

allowing recording of said information on said recording medium to effect charges for said information (i.e., the subscriber pays a first fee to view a program and pays a second higher fee in order to view and record the program) (Col. 2, lines 59-65 and Col. 3, lines 39-60).

Horton fails to specifically disclose providing a recording medium having an identifier; and recording said information on said recording medium based on a presence of said identifier.

In an analogous art, Yoo discloses providing a recording medium having an identifier (i.e., tape ID code) (Col. 4, lines 27-52); and recording said information on said recording medium based on a presence of said identifier (i.e., before recording of a desired program can begin, microcomputer 90 must first detect the presence of tape ID code on the recording medium in order to facilitate properly indexing the recording medium) (figure 2; Col. 4, lines 27-52 and Col. 5, lines 1-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Horton to include providing a recording medium having an identifier; and recording said information on said recording medium based on a presence of said identifier as taught by Yoo for the benefit of ensuring that the tape is properly indexed according the method being used by the recording system, (i.e., the video library system as disclosed by Yoo, Col. 2, lines 21-62).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS PARRY whose telephone number is (571) 272-8328. The examiner can normally be reached on Monday through Friday, 8:00 AM EST to 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN MILLER can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

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